

**UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

HAROLD SCHOENHAUS and RICHARD  
M. JAY,

Plaintiffs

v.

GENESCO, INC. and JOHNSTON &  
MURPHY, INC.,

Defendants,

CIVIL ACTION

No. 03-0372

August 10, 2005

**MEMORANDUM / ORDER**

Currently before the court is defendants' Petition to Forward Portions of the Record to the Federal Circuit. The petition specifically requests forwarding of Docket Index No. 45, Exhibit 45, Declaration of Lloyd S. Smith, D.P.M. – Exhibit O example of rigid material. The petition is submitted under the authority of Fed. R. App. Proc. 11(e)(1), which states that “a party may at any time during the appeal request that designated parts of the record be forwarded.”

Plaintiffs contest the Petition, arguing that the physical specimen was never included in the record and that Exhibit O consists exclusively of a photocopy of a photograph of the specimen that defendants now seek to have forwarded. Defendants maintain that the photocopied photograph was simply a placeholder for the physical specimen, which they retained for anticipated discovery purposes.

It is clear from Dr. Smith's Declaration that Exhibit O references the actual rigid material,

and not a pictorial representation of it. *See* Ex. 45 of Docket #45, ¶18 (“The next element of Claim I of the ‘052 patent is ‘comprising a deep rigid heel seat to cup the calcaneus.’ The Genesco insert has a soft heel seat. Persons in my field understand that a ‘rigid’ orthotic is one that exhibits the ordinary meaning of rigid, .... *I have attached as Exhibit O hereto, an example of a ‘rigid’ material widely used to make orthotics.*” (emphasis added).

Further, defendants brought the physical specimen to plaintiffs’ deposition of Dr. Smith, and the transcript from that deposition reveals that plaintiffs’ counsel asked to have the exhibit produced, and that it was produced. *See* Lloyd S. Smith, D.P.M., Dep. Tr. at 104.17-105.19 (Apr. 8, 2004). Moreover, plaintiffs’ counsel clearly understood that Exhibit O was the physical specimen itself, and not a pictorial representation of it. *See id.* at 104.19-105.3.

In short, plaintiffs had both notice that the physical specimen was to be included in the record, and an opportunity to study that specimen. Plaintiffs are thus not in a position to argue that the specimen’s inclusion in the record would surprise or unduly prejudice them.

Accordingly, it is hereby ORDERED that defendants’ petition is GRANTED. The Clerk of Court shall forward the exhibit listed above to the Federal Circuit Court of Appeals.

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Pollak, J.